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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/463,705 02/23/00 CORTES

J 146.1335

HM12/0125

BIERMAN MUSERLIAN AND LUCAS
600 THIRD AVENUE
NEW YORK NY 10016

EXAMINER

RAO, M

ART UNIT

PAPER NUMBER

1652

DATE MAILED:

01/25/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/463,705

Applicant(s)

Cortese et al.

Examiner

Manjunath N. Rao

Group Art Unit

1652



☒ Responsive to communication(s) filed on Dec 11, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 2-16 and 20-45 is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 2-16 and 20-45 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 2-15 and 42-43, drawn to polynucleotide, polypeptide and the first method of use.

Group II, claims 16 and 44, drawn to use of DNA as hybridization probes.

Group III, claims 20-22, drawn to polynucleotides (Oleandomycin biosynthesis genes).

Group IV, claim 23, drawn to polypeptide of ORF-Ole G1.

Group V, claim 24, drawn to polypeptide of ORF-OleG2.

Group VI, claims 25-33, drawn to process of preparation of hybrid metabolites.

Group VII, claims 34-38, drawn to modified strains of fungi.

Group VIII, claims 39-40, drawn to preparation of precursors of oleandomycin.

Group IX, claim 41, drawn to dTDP-D-desosamine.

Group X, claim 45, drawn to process for isolating genes for glycosylation of macrolactone.

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2. The inventions listed as Groups I-X do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The inventions listed as Groups I, III-V, VII and IX are each unrelated and chemically distinct products which are unrelated in structure and function. The methods of groups II, VI and X do not share any special technical feature of groups III-VI and IX and do not share a special technical feature of group I as the main invention shall consist of the first invention, the first recited process of use thereof and the first recited method of making the product but does not provide for inclusion of multiple methods of use within the main invention.

3. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

Group I: Polynucleotides 1) eryBII; 2)eryCIII; 3) eryCII; 4)eryAI; 5)eryBIV; 6) eryBV; 7)eryCVI; 8)eryBVI; 9)eryCIV; 10)eryCV; 11)eryBVII and each of their respective polypeptide.

Group II: Polynucleotides 1)eryBII; 2)eryCIII; 3) eryCII; 4) eryBV; 5)eryCVI; 6)eryBVI; 7)eryCIV; 8)eryCV; 9)eryBVII.

Group III: DNA sequences oleG1, oleG2

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Group VI: 2,3-reductase, desosaminyltransferase, 3,4-isomerase, 4-reductase, mycarosyltransferase, methyltransferase, 2,3-deshydratase, 3,4-deshydratase, 3,4-reductase, 3,5-epimerase.

Group VII: modified strain B1192, BIV87, CIV89, BV88

Applicant is required, in reply to this action, to elect a single species (in the elected group) to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

4. The following claim(s) are generic: Group I, claims 2 and 5; Group II, claims 16 and 44; Group III, claim 20; Group VI, claims 25-26; Group VII, claim 34.

5. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special

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technical features for the following reasons: Species are either unrelated polynucleotides, polypeptides, fungal strains and secondary metabolites.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

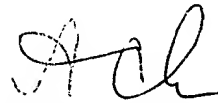
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manjunath Rao whose telephone number is (703) 306-5681. The Examiner can normally be reached on M-F from 6:30 a.m. to 3:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, P.Achutamurthy, can be reached on (703) 308-3804. The fax number for Official Papers to Technology Center 1600 is (703) 305-3014. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



PONNATHAPACHUTUR MURTHY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

Manjunath N. Rao

January 12, 2001